



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
JAN 26 2004
TC 1700

In Application of

Toshiaki KUBO

Serial No. 09/640,803

Group Art Unit: 1752

Filed: August 18, 2000

Examiner: Thorl Chea

For: THERMALLY PROCESSED IMAGE FORMING MATERIAL

DECLARATION UNDER 37 CFR 1.132

Honorable Commissioner of Patents and Trademarks,
Washington, D.C. 20231

Sir:

I, Toshiaki KUBO, a Japanese citizen, having a post office address of
c/o Fuji Photo Film Co., Ltd., No.210, Nakanuma Minami-ashigara-shi,
Kanagawa 250-0193 Japan, hereby declare and state that:

I received a Master's Degree in organic chemistry from Kobe
University, the department of Chemistry, in March of 1989,

I was employed by Fuji Photo Film Co., Ltd. in April of 1989 and
since that time to March of 1993 I had been principally engaged in research
and development of synthesis of dyes, and

since April of 1993 I have been principally engaged in research and
development of photosensitive materials for printing at Ashigara
Laboratories of the company.

I declare further that I have read all of the documents contained in
the file wrapper of the above-entitled application.

I declare further that the test described below was conducted at my direction and under my supervision and the test results are true and correct to the best of my knowledge.

Method:

Sample No. 2 in Example 1 of EP 0902322 was prepared as described in the publication. Modified Sample No. 2 was prepared in the same manner except that Snowtex C was not added to the protective layer of the back side in order to adjust the ratio of Vickers Hardness to satisfy the claimed conditions.

Vickers Hardness of both surfaces of these samples was measured in the manner described in page 7, lines 18-31 of the present specification and the ratio of Vickers Hardness was calculated. Adhesiveness of the samples was evaluated by the process set forth in page 58, line 28 to page 59, line 5 of the present specification.

Results:

Results are shown in the following table.

| Sample | Ratio of Vickers Hardness | Evaluation of Adhesion |
|-----------------------|---------------------------|------------------------|
| Sample No.2 | 0.06 | 2 |
| Modified Sample No. 2 | 0.13 | 3 |

Discussion:

The test results indicate that Sample No. 2 is not included in the present Claims 1, 3-6, 8-13 because the ratio of Vickers Hardness is out of

the claimed range. Further, the other inventive samples in Table 24 of EP0902322 have the same outermost layers in both sides as in Sample No. 2. Thus, no sample shown in the Example of EP0902322 satisfies the claimed condition regarding the ratio of Vickers Hardness.

I believe that the present Claims 1, 3-6, 8-13 are not anticipated by EP0902322.

In regard to the Evaluation of Adhesion, Sample No. 2 rated as "2", i.e. "adhesion mark accounts for approx. 30% of the sample surface area", is improper for the practical use, while Modified Sample No. 2 rated as "3" is proper for the practical use. The difference is significant and the superiority of Modified Sample No.2 is clearly shown.

Advantageous effects of samples satisfying the claimed condition regarding the ratio of Vickers hardness is also shown in Table 4 of the present specification.

I believe that no one skilled in the art reading EP0902322 would have expected the advantages effects before the claimed invention was made.

Further, EP0902322 makes no mention of Vickers Hardness and its relationship between the outermost layer on the first side and the outermost layer on the second side. I believe that no one skilled in the art reading EP0902322 would have been motivated to adjust Vickers Hardness of the both sides to satisfy the claimed conditions before the claimed invention was made.

I believe that the present Claim 1, 3-6, 8-13 would have been non-obvious, at the time the invention was made, to person skilled in the art reading EP0902322.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issuing thereon.

Dated this 16th day of January, 2004.



Toshiaki KUBO